



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,495	03/18/2004	Donald R. Titterington	A0306-US-DIV	7713
21567 7590 06/25/2007 WELLS ST. JOHN P.S. 601 W. FIRST AVENUE, SUITE 1300 SPOKANE, WA 99201			EXAMINER SERGENT, RABON A	
			ART UNIT 1711	PAPER NUMBER
			MAIL DATE 06/25/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/804,495

Applicant(s)

TITTERINGTON ET AL.

Examiner

Rabon Sergeant

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Art Unit: 1711

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 18, 2007 has been entered.
2. Claims 27-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In view of applicants' amendment to claim 27, it is unclear if applicants are stating that a product of the reacting is itself reacting with the alcohol or if applicants are stating that the alcohols comprise fused ring alcohols and a product of the reacting or if applicants are stating that the product that results from the reacting is a non-polymeric urethane resin. The position is taken in view of the language and punctuation of the claim that the claim is ambiguous to such an extent that the claim cannot be clearly understood.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 27-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Hays ('477).

Patentees disclose the production of oligomeric reaction products of isocyanates and rosin-based capping agents, such as hydroabietyl alcohol, suitable for use within ink compositions. See abstract; column 3, lines 21+; column 4, lines 7+; column 6, lines 26+; and

Art Unit: 1711

column 7, lines 23-26. In view of the disclosed product and its use and further in view of the fact that the respective reactants are equivalent, the position is taken that specifying the ink as a phase change ink fails to distinguish the claims from the prior art, because one would reasonably expect the ink of Hays to inherently be a phase change ink.

5. Applicants' response of June 18, 2007 has been carefully considered. Despite applicants' arguments, the inherency position has been maintained for the aforementioned reasons. Given that the respective compositions are derived from reactants that have not been distinguished and that it is the urethane resin that is responsible for the phase change characteristic, the position is maintained that one would reasonably expect the disclosed ink to have phase change properties. Furthermore, applicants' argument that the examiner has failed to establish that the Hays oligomer, prior to capping, is isocyanate functional is without merit. It is clear from the disclosure at column 4, lines 46-49 and column 6, lines 26+ that the oligomer is produced from a stoichiometric excess of diisocyanate; this excess yields an isocyanate terminated oligomer. Upon reaction of this isocyanate terminated oligomer with the disclosed capping agent, such as hydroabietyl alcohol, a non-polymeric urethane resin results that meets that claimed.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference

Art Unit: 1711

claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 21-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the following claims of the following copending applications:

<u>Application</u>	<u>Claim</u>
10/898,724	19 and 20
10/902,602	96 and 97
11/291,057	57 and 58
11/496,231	27
11/496,612	21 and 22

Art Unit: 1711

Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of copending claims is drawn to phase change ink compositions or their use, wherein the compositions are derived from fused ring alcohols, such as hydroabietyl alcohol, and either cyclohexyl isocyanate or isophorone diisocyanate. The position is taken that one of ordinary skill in the art in possession of the phase change ink composition would have also been in possession of the method of making it. Furthermore, the phase change ink composition, by its very name and nature, renders the use of the composition, to the extent claimed, obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 21-32 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13 and 14 of U.S. Patent 7,211,131. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims is drawn to phase change ink compositions or their use, wherein the compositions are derived from fused ring alcohols, such as hydroabietyl alcohol, and isophorone diisocyanate. The position is taken that one of ordinary skill in the art in possession of the phase change ink composition would have also been in possession of the method of making it. Furthermore, the phase change ink composition, by its very name and nature, renders the use of the composition, to the extent claimed, obvious.


9. Applicants have argued that due to the Office's administrative delay, a showing of two-way obviousness is required, and that the examiner has not set forth this required analysis. In response, applicants' argument is not well taken. In the instant case, a two-way obviousness

Art Unit: 1711

analysis is not warranted, because contrary to applicants' assertions, the Office has not created administrative delay. It is gathered from applicants' arguments that they believe the Office's requirement for restriction created the argued administrative delay; however, a requirement for restriction is not seen to constitute administrative delay, since it constitutes a legitimate and sanctioned Office practice in the course of patent application examination.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
June 20, 2007


RABON SERGENT
PRIMARY EXAMINER